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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,490	06/23/2003	Michael C. Stewart	26448-07311	1114
758 7590 01/16/2009 FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041				
EXAMINER NGUYEN, VI X				
ART UNIT		PAPER NUMBER		
3734				
MAIL DATE		DELIVERY MODE		
01/16/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/602,490

Applicant(s)

STEWART ET AL.

Examiner

Victor X. Nguyen

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5, 9-11, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) 14-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 9-11, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date 12/8/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2,5,9,10-11 and 30-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Yates et al (5,688,270).

Yates et al disclose in figures 4,6-7 and 14-16, a surgical device for treating tissue having the limitations as recited in the above listed claims, including: a pair of yoke shaped members at 32,34 mounted in spaced substantially plane parallel array with each member formed as a planar sheet including tines 32a extending distally which includes a slot opening (the slot opening occurs at either side of element 32,34), or a pair of yoke members which operable as an electrode of one or other polarity (element 27,28 or 39,each can be operated as an electrode), a cutter 11 mounted intermediate the spaced members for movement in a plane parallel to and spaced from the members which also discloses a cutting edge, where the cutter is displaced from obstructing transverse alignment (fig. 4) of the slotted opening. The intended use of for transversely severing tissue disposed in the slotted openings and across the spacing of the members must result in additional steps to be performed between the claim invention and the prior art in order to

patentably distinguish the claimed invention from the prior art. Since the prior art is capable of performing the intended use, then it meets the claim; see MPEP 2106, and where an actuator 41 which links to the cutter for controlling movement between the open and closed configurations, and where the device further includes a mounting structure at 33 which disposes at the distal end of an elongated body 38 to support the members in spaced array with the slots, the mounting structure also supports the cutter for movement the intermediate members, where the actuator further comprises a manual manipulator at 60 mounted near the proximal end of the body and linked to the actuator for moving the cutter. Note that the procedure in fig. 22 discloses the width of each of the slots openings convergingly tapers inwardly from the forward edge, and where the device further includes electrical connections to each of the members for applying electrocautery signals thereto (see abstract), where the cutter also includes a contoured surface for engaging a reference surface to transform translational movement of the cutter into translational and lateral movement relative to the anvil 18, and where the reference surface includes a wear resistant which disposes at the distal end of the body to engage the contoured surface of the cutter.

Response to Arguments

2. Applicant's arguments filed 11/13/2008 have been fully considered but they are not persuasive. Applicant states that Yates's device does not suggest a pair of yoke shaped members are formed as planar sheet and is operable as one electrode. Examiner disagrees. It is noted that fig. 14 of Yate can be clearly defined a pair of yoke shaped which is simply resembled as a pair of conventional jaws 32,34 which is in a planar sheets and is capable of operable as one electrode 27,28 or 39 . The examiner recommends further description of the yoke shaped members to overcome the prior art. In response to applicant's argument that Yate does not include an anvil.

Examiner disagrees. In fact, it is noted that jaw member 32 comprises an anvil 18 (see col. 5, lines 55-57 and col. 6, lines 65-67). Accordingly, the above noted reference is still considered to read on the claimed limitations of the claims noted.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ho Jackie can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/
Primary Examiner, Art Unit 3734

/Victor X Nguyen/
Examiner
Art Unit 3734

VN